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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,157

08/21/2006

Toru Kodo

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04/13/2009

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EXAMINER

KWON, BRIAN YONG S

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

04/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,157	<b>Applicant(s)</b> KODO ET AL.	
	<b>Examiner</b> Brian-Yong S. Kwon	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 3-21 and 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 22-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/09/07, 11/17/06, 08/21/06</u> .                            | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Applicants Response to Election of Species Requirement Acknowledged***

1. Applicant's election with Example 338 compound is acknowledged. Because applicant did not specifically traverse the election of species requirement, the election has been treated as an election without traverse.
2. The applicant's elected species appears to be allowable over the prior art. Thus, the examiner will extend the search to other non-elected species represented by the formula (1) where X is O; R1 and R2 are independently a hydrogen or an optionally substituted alkyl group; R3, R4, R5, R6, R7, R8 are hydrogen and examine for prosecution on the merits of the case. Claims 1-2 and 22-23 read on the elected species.

Claims 3-21 and 24-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected claims.

### ***Information Disclosure Statement***

3. Acknowledgement is made of the information disclosure statements (IDS) filed on 08/21/06, 11/17/06 and 11/09/07. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement (IDS) has been considered by the examiner.

With respect to "English Translation of PCT Written Opinion for PCT/JP2005/003095" in the submitted PTO-1449, the information disclosure statement filed 11/09/07 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office.

***Claim Objections***

4. Claims 1-2 are objected to because of the following informalities: Applicant's use of same numerical values for formulas, claim numbers and various elements or steps in the claims make claims extremely confusing to understand. Appropriate correction is required.

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

***Claim Rejections - 35 USC § 112 – 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-2 and 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. This is a written description rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. Applicant is directed to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, 1<sup>st</sup> "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

Art Unit: 1614

The claims are drawn to methods of administering compounds of Formula (1), (2), (3), (4), (5) (1'), (2'), (3'), (4') (1''), (2''), (3'') or (4'') or "prodrug" thereof.

*Vas-Cath Inc. V. Mahurkar*, 19 USPQ2d 1111, states that Applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention, for purposes of the written description inquiry, is whatever is now claimed (see page 1117). A review of the language of the claims indicates that these claims are drawn to a generic genus, *i.e.*, generic prodrugs of said compounds of the formulas.

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof.

A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). In *Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that, while applicants are not required to disclose every species encompassed by a genus, the description of the genus is achieved by the recitation of a representative number of

Art Unit: 1614

species falling within the scope of the claimed genus. At section B(i), the court states, "An adequate written description of a DNA ... requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention."

Applicants provide no description of the claimed prodrugs of compounds of formulas, either in word, by structure, by formula, by chemical name, or by physical properties that would indicate that Applicants were in possession of the claimed prodrugs at the time of the invention. Applicants define a "prodrug" as a compound which is "easily be acid-hydrolyzed or enzymatically degraded in the living body" (page 40). However, Applicants do not describe the structural features of such prodrugs that would result in a compound that is quickly degraded in vivo into a pharmacologically active compound of said formulas.

In the absence of sufficient recitation of distinguishing characteristics, the specification does not provide adequate written description of the claimed genus, which is a generic genus of compounds, *i.e.*, generic prodrugs of said formulas purported to have antianxiety or antidepressant activity. One of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus. The specification does not clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed (see *Vas-Cath* at page 1116).

Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. 112 is severable from its enablement provision (see page 1115).

Art Unit: 1614

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2 and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 10-11, 17-19, 22-23 and 26 recite "an optionally substituted alkyl group, an optionally substituted cycloalkyl group, an optionally substituted alkenyl group, an optionally substituted alkynyl group, an optionally substituted saturated heterocyclic group", "an optionally substituted alkoxy group, an optionally substituted alkanoyl group, an optionally substituted alkoxycarbonyl group, an optionally substituted aryloxycaronyl group, an optionally substituted heteroaryloxycarbonyl group...an optionally substituted carbamoyl group, an optionally substituted sulfamoyl group, an optionally substituted ureido group, an optionally substituted alkythio....". It is not clear as being confused what "substitued" refers to. The claims are vague and unclear and leave the reader in doubt as to the meaning of the invention to which they refer, thereby rendering the definition of the subject-matter of said claims unclear. In this regard, although the examples of suitable substituents are shown in the specification, it is considered that the meaning of the claims should be clear from the wording of the claim alone.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1614

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2 and 22-23 rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Hagmann et al. (WO 2003077847).

Hagmann discloses a compound presented by the instant formula as antagonists and/or inverse agonists of CB1 receptor that is useful for the treatment of various disease conditions including anxiety disorder, wherein said compound is prepared in various pharmaceutical formulations (abstract; page 3, lines 12-25; page 3, line 31 through page 4, line 28; claims 7 and 17 and Example 5 in page 199).

### Conclusion

8. No Claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax number for this Group is (571) 273-8300.



Art Unit: 1614

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Brian-Yong S Kwon/  
Primary Examiner, Art Unit 1614